

R E M A R K S

Claims 13-26 are pending. All claims are under examination. No claims are allowed. The only grounds of rejection are for alleged lack of novelty under 35 USC 102(e) and for alleged obviousness under 35 USC 103. Both grounds of rejection rely on US 6,569,216 B1 (Taira). Since Taira is not prior art under either section of the patent statute, all grounds of rejection must be withdrawn.

Issues under 35 USC 102(e)

The rejection of claims 13, 14, and 16-26 in paragraph 3 on page 3 of the last Office Action over Taira under 35 USC 102(e) is traversed.

The Taira reference can not be used as prior art since Taira is a PCT application filed prior to November 29, 2000, and thus the "(e)" date thereof is the date of national entry into the United States i.e. May 25, 2001, irrespective of its publication language. The U.S. filing date of the pending application is April 27, 2001 which is earlier than Taira's "(e)" date.

Also, even under the new 35 USC 102(e), Taira is not applicable prior art. The new 35 USC 102(e) patent statute contains two, and only two, subsections namely subsection (1) and subsection (2). For reasons which appear more fully below, Taira is not prior art

under either subsection and is therefore not prior art under new 35 USC 102(e).

The first sub section, 35 USC 102(e) (1), reads:

A person shall be entitled to a patent unless -
(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent

Taira was filed in the United States on May 25, 2001, after the April 27, 2001, filing date of the instant case. After is not "before" as required by 35 USC 102(e) (1). Tiara is therefore not prior art under 35 USC 102(e) (1).

The second sub section, 35 USC 102(e) (2) reads:

A person shall be entitled to a patent unless -
(e) the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. . . [35 U.S.C. 102(e) emphasis supplied]

Taira is not prior art since it was not published "in the English language" as required under the statute. It was published in the Japanese Language as shown by the WIPO print-out attached hereto as Exhibit A. On Exhibit A Item "(26)" reads: "Japanese"

meaning that the language of publication of Taira was Japanese not English as required under 35 USC 102(e)(2).

Accordingly, under each of the previous and new 35 USC § 102(e) statutes, Taira is not prior art.

Issues under 35 USC 103

The rejection of claim 15 in paragraphs 5-7 of the last Office Action as obvious over Taira is traversed because Taira can not be used as prior art in an obviousness rejection under 35 USC 103 because of the common ownership exception of 35 USC 103(c).

The Examiner acknowledges that if Taira is prior art, such is true only by virtue of 35 USC 102(e). The Examiner alleges that other "Claims. . . are rejected under 35 USC 102(e) as being anticipated by Taira. . . "[last Office Action page 4, line 1].

Taira is assigned on its face to KAO Corporation (KAO). The instant application is assigned to KAO by an assignment recorded amongst the PTO records on reel 011757 at frame 0957. Taira and the instant application are owned by the same person i.e. KAO. The obviousness section of the patent statute, 35 USC 103 is clearly not applicable under this fact situation because of the exception in section (c) of 35 USC 103, which reads as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. [35 USC 103(c); emphasis supplied]

The statute requires that Examiner withdraw this ground of rejection.

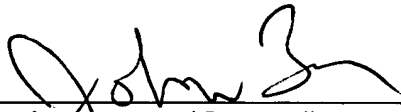
Conclusion


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

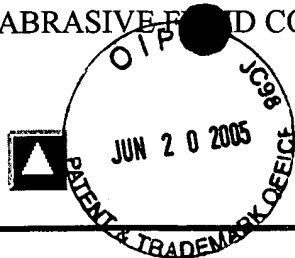
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JWB/DRM: bmp
1422-0472P

Attachments:

- Exhibit A: "INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT) printed from www.wipo.org on 4/22/2005 showing that Taira was published in the Japanese language. (2 pages)
- Exhibit B: Filing receipt for US Application No. 09/856,713 showing that the Taira was filed in the USA on May 25, 2001, after the filing of this application.



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Images

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(11) WO 00/32712

(13) A1

(21) PCT/JP99/06592

(22) 26 November 1999 (26.11.1999)

(25) Japanese

(26) Japanese

(30) 10/336416

27 November 1998

JP

(27.11.1998)

11/207473

22 July 1999

JP

(22.07.1999)

(43) 08 June 2000 (08.06.2000)

(51)⁷ C09K 3/14

(54) ABRASIVE FLUID COMPOSITIONS

(71) KAO CORPORATION [JP/JP]; 14-10, Nihonbashi Kayabacho 1-chome, Chuo-ku, Tokyo 103-8210 (JP).

(72) TAIRA, Koji [JP/JP]; Kao Corporation, Research Laboratories, 1334, Minato,

(75) Wakayama-shi, Wakayama 640-8580 (JP). FUJII, Shigeo [JP/JP]; Kao Corporation, Research Laboratories, 1334, Minato, Wakayama-shi, Wakayama 640-8580 (JP). OSHIMA, Yoshiaki [JP/JP]; Kao Corporation, Research Laboratories, 1334, Minato, Wakayama-shi, Wakayama 640-8580 (JP). NAITO, Koichi [JP/JP]; Kao Corporation, Research Laboratories, 1334, Minato, Wakayama-shi, Wakayama 640-8580 (JP).

(74) HOSODA, Yoshinori; Hosoda International Patent Office, Otemae M2 Building, 8-1, Tanimachi 2-chome, Chuo-ku, Osaka-shi, Osaka 540-0012 (JP).

(81) KR, US

Published

-- with international search report

(57) An abrasive fluid composition comprising a chelating compound or a salt thereof, a partially esterified and/or partially etherified polyhydric alcohol compound, and water; an abrasive fluid composition comprising water, an abrasive material, an intermediate alumina, and a chelating compound or a salt thereof, characterized in that the content of the intermediate alumina is 1 to 50 parts by weight per 100 parts by weight of the abrasive material; and an abrasive fluid composition comprising water, an abrasive material, an intermediate alumina, a chelating compound or a salt thereof, and a partially esterified and/or partially etherified polyhydric alcohol compound, characterized in that the content of the intermediate alumina is 1 to 50 parts by weight

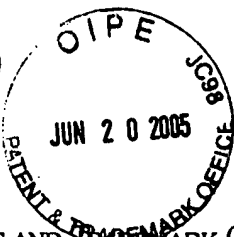


per 100 parts by weight of the abrasive material. Use of any of the abrasive fluid compositions is effective in improving abrasion rate and reducing the surface roughness of a work without generating defects, such as scratches or pits, on the surface of the work.



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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/856,713	05/25/2001	1755	1166	1422-0479P		14	3

CONFIRMATION NO. 3227

2292
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FILING RECEIPT



OC000000006294986

Date Mailed: 07/13/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

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Domestic Priority data as claimed by applicant

THIS APPLICATION IS A 371 OF PCT/JP99/06592 11/26/1999

Foreign Applications

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JAPAN 11/207473 07/22/1999

Projected Publication Date: N/A

Non-Publication Request: No

Early Publication Request: No

Title

Abrasive fluid compositions

